

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDER R. POKORA
and MARK A. JOHNSON

Appeal No. 95-2444
Application 07/973,655¹

ON BRIEF

Before RONALD H. SMITH, Administrative Patent Judge and McKELVEY, Senior Administrative Patent Judge and HANLON, Administrative Patent Judge.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-12, all of the claims pending in the application.

The claims are directed to a process for treating a

¹ Application for patent filed November 9, 1992.

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lignocellulosic pulp with soybean peroxidase in the presence of a peroxide and removing lignin from the pulp. Appellants disclose that suitable pulps for the practice of the invention include kraft pulp (Specification, p.4). Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. A process which comprises treating a lignocellulosic pulp with soybean peroxidase in the presence of a peroxide, and removing lignin from said pulp.

The references relied upon by the examiner are:

Johnson et al. (Johnson)	5,147,793	Sep. 15, 1992
Vaherl et al. (Vaherl) (European Patent Application)	0 395 792	Nov. 7, 1990
Canadian Patent Application	2,019,411	Dec. 22, 1990

The following rejections are at issue in this appeal:

(1) Claim 1 is rejected under 35 U.S.C. § 102(a) or (e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over the '793 patent.²

(2) Claims 1-4, 6 and 9-12 are rejected under 35 U.S.C. § 103 as being unpatentable over Canadian patent application no.

² The examiner refers to U.S. Patent No. 5,147,793, as "Cyrus, Jr. et al." throughout the final Office action and the answer, and appellants refer to this same reference as "Johnson '793." We will refer to U.S. Patent No. 5,147,793 as "the '793 patent".

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2,019,411 in view of the '793 patent.

(3) Claims 7 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Canadian patent application no. 2,019,411 in view of the '793 patent, and further in view of the admitted prior art (Specification, p.5, lines 20-22).

(4) Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over Canadian patent application no. 2,019,411 in view of the '793 patent, and further in view of European patent application no. 395,792.

Grouping of claims

According to appellants, "[f]or purposes of this appeal, all claims stand or fall together" (Brief, p.3). Therefore, dependent claims 2-12 stand or fall with the patentability of independent claim 1.

Rejection of claim 1 under 35 U.S.C. § 102(a) or (e) or, in the alternative, under 35 U.S.C. § 103 over the '793 patent

The '793 patent discloses that soybean peroxidase is useful "in enzymatic bleaching of Kraft pulp" (col. 10, lines 44-45). The examiner maintains that this teaching either anticipates or renders claim 1 obvious (Answer, pp.2-3).

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Appellants argue that (Brief, pp.3-4):

Johnson '793 is not a proper reference to serve as a basis of rejection for the claims under 35 U.S.C. §102(a) or (e). The inventors, Mr. Pokora and Mr. Johnson, along with Mr. Cyrus, Jr. have submitted a Declaration under 37 C.F.R. §1.132 which states that they are the joint inventors of Johnson '793 and that Mr. Johnson and Mr. Pokora are the inventors of the process for using soybean peroxidase to bleach Kraft pulp described in the Johnson '793 patent. These Declarations eliminate Johnson '793 as prior art because they establish that the reference to bleaching Kraft pulp in Johnson '793 is not the disclosure or invention of another, but rather is the invention of Johnson and Pokora, the applicants.

The declaration under 37 CFR § 1.132 reads, in pertinent part, as follows:

We, Mark A. Johnson, Alexander R. Pokora and William L. Cyrus, Jr., declare and state the following:

(1) We are joint inventors of U.S. Patent No. 5,147,793;

(2) The subject matter relating to the use of soybean peroxidase in enzymatic bleaching of kraft pulp at column 10, lines 44-45 of U.S. Patent No. 5,147,793, but not claimed therein, is the invention of Mark A. Johnson and Alexander R. Pokora and is not the invention of William L. Cyrus, Jr.; and

(3) Mark A. Johnson and Alexander R. Pokora conceived of the subject matter

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disclosed and claimed in U.S. Patent
Application No. 07/973,655 prior to the
filing date of U.S. Patent No. 5,147,793.

The declaration was signed by the three patentees of the '793
patent, Mark A. Johnson, Alexander R. Pokora and William L.
Cyrus, Jr.³

The examiner maintains that the declaration fails to remove
the '793 patent as prior art under 35 U.S.C. § 102(a) and (e) for
the reason that (Answer, p.5):

[T]he claims of CYRUS, JR. ET AL call for the
"biocatalytic oxidation of an oxidizable
substrate". The claims are not limited to
the polymerization reactions of the Examples.
When CYRUS JR. ET AL is read in view of its
specification the claimed "biocatalytic
oxidation" would include the disclosed
"bleaching", and the claimed "oxidizable
substrate" would include the disclosed "kraft
pulp". Thus the claims of CYRUS JR. ET AL
would include bleaching of Kraft pulp which
includes the delignification (Kraft bleaching
and/or delignifying) of lignocellulosic
material (pulp), see the instant
specification, page 3, lines 18-22. Thus the
claimed subject matter of the instant
Application, was disclosed and claimed in
Patent No. 5,147,793.

We note at the outset that the declarants expressly state

³ Three copies of this declaration were received, one signed by Mark A. Johnson dated December 9, 1993, one signed by William L. Cyrus, Jr. dated December 13, 1993, and one signed by Alexander R. Pokora dated December 28, 1993.

that "[t]he subject matter relating to the use of soybean peroxidase in enzymatic bleaching of kraft pulp at column 10, lines 44-45 of U.S. Patent No. 5,147,793" is not claimed therein (Declaration, ¶2). Claim 1 of the '793 patent recites a method for biocatalytic oxidation of an oxidizable substrate comprising (1) preparing a solution of the oxidizable substrate and (2) contacting the solution with soybean hulls in the presence of a peroxide. First, the treated lignocellulosic pulp in appellants' claim 1 is not in solution. Second, soybean hulls are not the same as soybean peroxidase, required in appellants' claim 1. Rather, soybean hulls are one of several elements used to produce soybean peroxidase ('793 patent, col. 12, line 46 through col. 13, line 3; appellants' specification, p.3, lines 22-24). Therefore, the same invention is not claimed in appellants' application and the '793 patent.

The declaration under 37 CFR § 1.132 is sufficient and removes the '793 patent as available prior art under 35 U.S.C. § 102(a) and (e). See MPEP § 716.10 (6th ed. Rev. 2, July 1996) ("When subject matter, disclosed but not claimed in a patent application issued jointly to S and another, is claimed in a later application filed by S, the joint patent is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or

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(f) unless overcome by . . . an unequivocal declaration by S
under 37 CFR 1.132 that he or she conceived or invented the
subject matter disclosed in the patent."); see also In re DeBaun,
687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982); In re Katz, 687
F.2d 450, 215 USPQ 14 (CCPA 1982). Accordingly, we reverse the
rejections based on the '793 patent alone and the rejections

based on the '793 patent in combination with any other reference
or references.

The decision of the examiner is reversed.

REVERSED

RONALD H. SMITH
Administrative Patent Judge

FRED E. McKELVEY, Senior
Administrative Patent Judge

ADRIENE LEPIANE HANLON
Administrative Patent Judge

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THOMPSON, HINE and FLORY
2000 Courthouse Plaza N.E.
P.O. Box 8801
Dayton, Ohio 45401-8801